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EXAMINER

SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/813,192

Applicant(s)

SHINOHARA, HIROAKI

Examiner

James Sheleheda

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 33-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 16 and 35 are objected to because of the following informalities:

In claim 16, line 3, "programming said electronic publication" should be changed to --programming and said electronic publication--.

In claim 35, line 2, "when demands on the system for are minimal" should be changed to --when demands on the system are minimal--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 7, 13-15, 18, 22, 23, 26, 28, 30, 33, 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Levitan (5,864,823).

As to claim 1, Levitan discloses a system for producing television signal (Fig. 3) comprising:

television programming (television programming from the TV network; Fig. 3; column 7, line 49-column 8, line 18); and

an electronic publication (newspapers, magazines; column 7, lines 50-62);

wherein said electronic publication comprises an electronic magazine that is independent of said television programming (ordered newspapers and magazines; column 7, lines 50-62); and

wherein said system automatically distributes said electronic magazine (automatically scheduled and transmitted by the television network center; column 7, lines 4-9) periodically to subscribers (column 7, lines 50-52).

As to claim 2, Levitan discloses wherein said signal is digital (column 8, lines 4-12).

As to claim 7, Levitan discloses a method of distributing an electronic publication (column 2, lines 33-59), said method comprising:

incorporating data for said electronic publication in a television signal along with television programming (column 7, line 49-column 8, line 18), wherein said electronic publication comprises an electronic magazine (column 7, lines 50-54) which is produced periodically (column 7, lines 50-52) and is independent of and does not refer to said television programming (ordered newspapers and magazines; column 7, lines 50-62);

broadcasting said television signals to users (column 8, lines 4-18); and

automatically receiving and storing said electronic magazine (wherein an authorized recipient automatically receives and stores the product; column 8, lines 4-18) each time said magazine is offered (each time the user chooses to order the product; column 8, lines 4-18).

As to claim 13, Levitan discloses billing recipients for said electronic publication (column 7, lines 57-62).

As to claim 14, Levitan discloses ordering said electronic publication (column 7, lines 49-64).

As to claim 15, Levitan discloses a system for distributing an electronic publication (Fig. 1), said system comprising:

a television signal broadcasting headend (television network center, 10), wherein a television signal broadcast from said headend comprises television programming and an electronic publication (column 7, line 49-column 8, line 18) that is independent of said television programming (ordered newspapers and magazines; column 7, lines 50-62); and

a personal video recorder (Fig. 3) for extracting said electronic publication from said television signal for use by a user (Fig. 3; column 8, lines 12-17), wherein said personal video recorder stores both said selected television programming and said electronic publication (Fig. 3; column 6, lines 29-45 and column 7, line 64-column 8, line 3).

As to claim 18, Levitan discloses wherein said personal video recorder further comprises a connection to the Internet and an Internet browser (column 7, lines 37-43).

As to claim 22, Levitan discloses wherein said broadcasting headend further comprises a subscriber billing system for tracking distribution of electronic publications (column 8, lines 4-17) and billing recipients for said electronic publications (column 7, lines 57-62).

As to claim 23, Levitan discloses a system for distributing an electronic publication (Fig. 1), said system comprising:

first means (television network center, 10) for broadcasting a television signal comprising both television programming and an electronic publication (column 7, line 49-column 8, line 18) that is independent of said television programming (ordered newspapers and magazines; column 7, lines 50-62); and

second means for receiving said television signal and extracting said electronic publication from said television signal for use by a user (Fig. 3; column 8, lines 12-17);

wherein said second means selectively outputs either said electronic publication (column 8, lines 9-17 and column 5, lines 38-46) or selected television programming (VCR playback; column 6, lines 33-45) to a common display means (column 5, lines 41-46).

As to claim 26, Levitan discloses wherein said second means further comprises a connection to the Internet and an Internet browser (column 7, lines 37-43).

As to claim 28, Levitan discloses wherein said electronic publication comprises an electronic magazine (ordered newspapers and magazines; column 7, lines 50-62) that is regularly distributed on a periodic basis (column 7, lines 50-52).

As to claim 30, Levitan discloses wherein said first means further comprise means for tracking distribution of electronic publications (column 8, lines 4-17) and billing recipients for said electronic publications (column 7, lines 57-62).

As to claim 33, Levitan discloses wherein said electronic publication does not include an electronic programming guide (ordered newspapers and magazines; column 7, lines 50-62).

As to claim 35, Levitan discloses wherein said system transmits said electronic magazine at night or early in the morning when demands on the system are minimal (column 8, lines 12-18 and column 2, lines 47-52).

As to claim 36, Levitan discloses activating a personal video recorder during hours when said recorder is not otherwise used so as to receive and store said electronic magazine (column 8, lines 12-18 and column 2, lines 47-52).

Art Unit: 2617

4. Claims 1-6, 15, 18-20, 23, 26-28, 34, 37 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Matthews, III et al. (Matthews) (6,631,523) (of record).

As to claim 1, Matthews discloses a system for producing a television signal (Fig. 1; column 5, lines 41-49) comprising:

television programming (column 5, lines 41-49 and column 6, lines 21-32); and  
an electronic publication (EPG information transmitted with the television programming; Fig. 1, column 6, lines 21-64);

wherein said electronic publication comprises an electronic magazine that is independent of said television programming (wherein the EPG is transmitted and stored periodically regardless of the current television programming; column 7, lines 31-41);  
and

wherein said system automatically distributes said electronic magazine periodically to subscribers (column 7, lines 31-41).

As to claim 2, Matthews discloses wherein said signal is digital (column 6, lines 42-44).

As to claim 3, Matthews discloses wherein said signal is analog ((column 6, lines 42-44).



As to claim 4, Matthews discloses wherein said electronic publication comprises at least one hyperlink referencing a site on an electronic data network (column 9, lines 54-67 and column 10, lines 1-11).

As to claim 5, Matthews discloses wherein said electronic publication comprises an embedded video clip (column 7, lines 12-20).

As to claim 6, Matthews discloses wherein said electronic publication comprises an embedded audio clip (column 7, lines 12-20).

As to claim 15, Matthews discloses a system for distributing an electronic publication (Fig. 1), said system comprising:

a television signal broadcasting headend (22; column 5, lines 41-49), wherein a television signal broadcast from said headend comprises television programming (column 5, lines 41-49) and an electronic publication (EPG information transmitted with the television programming; Fig. 1, column 6, lines 21-64) that is independent of said television programming (wherein the EPG is transmitted and stored periodically regardless of the current television programming; column 7, lines 31-41); and

a personal video recorder (set top, 26) for extracting said electronic publication from said television signal for use by a user (column 7, lines 31-40 and column 9, lines 43-54), wherein said personal video recorder stores both selected television

programming (column 12, lines 16-27) and said electronic publication (Fig. 4, 104; column 8, lines 50-60).

As to claim 18, Matthews further discloses wherein said personal video recorder further comprises a connection to the Internet and an Internet browser (column 7, lines 15-20 and column 8, lines 60-65).

As to claim 19, Matthews discloses wherein said electronic publication comprises at least one hyperlink referencing a site on an electronic data network to which said personal video recorder is connected (column 9, lines 54-67 and column 10, lines 1-11).

As to claim 20, Matthews discloses a remote control unit (remote control, 30) for controlling said personal video recorder (column 5, lines 50-67) to access and output either said selected television programming (to playback the recorded program; column 12, lines 16-27) or said electronic publication to a video monitor connected to said personal video recorder (column 5, lines 50-67 and column 8, lines 50-60).

As to claim 23, Matthews discloses a system for distributing an electronic publication (Fig. 1), said system comprising:

first means (headend, 22) for broadcasting a television signal comprising both television programming (column 5, lines 41-49) and an electronic publication (EPG information transmitted with the television programming; Fig. 1, column 6, lines 21-64)

Art Unit: 2617

that is independent of said television programming (wherein the EPG is transmitted and stored periodically regardless of the current television programming; column 7, lines 31-41); and

second means for receiving said television signal (set top, 26) and extracting said electronic publication from said television signal for use by a user (column 7, lines 31-40 and column 9, lines 43-54);

wherein said second means selectively outputs either said electronic publication (Fig. 8, step 200; column 11, lines 56-67) or selected television programming (Fig. 8, step 212; column 12, lines 6-16) to a common display means (TV, 28; Fig. 1; column 5, lines 50-54).

As to claim 26, Matthews discloses wherein said second means further comprise a connection to an electronic data network (column 9, lines 54-67 and column 10, lines 1-11).

As to claim 27, Matthews discloses wherein said electronic publication comprises at least one hyperlink referencing a site on said network (column 9, lines 54-67 and column 10, lines 1-11).

As to claim 28, Matthews discloses wherein said electronic publication comprises an electronic magazine that is regularly distributed on a periodic basis (column 7, lines 31-42).

As to claim 34, Matthews discloses wherein said electronic publication comprises an interactive menu for skipping to different parts of the publication (EPG display allowing scrolling to different channels and times; column 8, line 66-column 9, line 11).

As to claim, 37 Matthews discloses wherein said electronic publication comprises an interactive menu for skipping to different parts of the publication (EPG display allowing scrolling to different channels and times; column 8, line 66-column 9, line 11).

As to claim 38, Matthews discloses wherein said electronic publication comprises an interactive menu for skipping to different parts of the publication (EPG display allowing scrolling to different channels and times; column 8, line 66-column 9, line 11).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levitan.

As to claim 8, while Levitan discloses receiving said television signal (column 8, lines 4-17); and

Art Unit: 2617

storing said electronic publication and selected television programming on digital data storage devices (Fig. 3; column 6, lines 29-45 and column 7, line 64-column 8, line 3), he fails to specifically disclose storing on a common digital data storage device.

The examiner takes Official Notice that it was notoriously well known in the art to use at the time of invention by applicant to utilize a mass storage device to store a plurality of information items, as opposed to requiring a plurality of separate storage devices, for the typical benefit of providing a simpler, cheaper system utilizing a single storage device.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Levitan's system to include storing on a common digital data storage device for the typical benefit of providing a simpler, cheaper system utilizing a single storage device.

As to claim 10, Levitan discloses controlling access and output of either said selected television programming (VCR playback; column 6, lines 33-45) or said electronic publication (column 8, lines 9-17 and column 5, lines 38-46) to a common video monitor (column 5, lines 41-46) with a user input device (column 5, lines 43-46).

7. Claims 16, 17, 21, 24, 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews.

As to claims 16 and 24, while Matthews discloses wherein the personal video recorder records the selected television programming and said electronic publication, he fails to specifically disclose a digital data storage device for recording both items.

The examiner takes Official Notice that it was notoriously well known in the art to use at the time of invention by applicant to utilize a digital data storage device, such as a typical hard drive, to store a plurality of information items, as opposed to requiring a plurality of separate storage devices, for the typical benefit of providing a simpler, cheaper system utilizing a single storage device.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Levitan's system to include a digital data storage device for recording both items for the typical benefit of providing a simpler, cheaper system utilizing a single storage device.

As to claims 17 and 25, Matthews discloses wherein said digital data storage device is a hard disk drive (see claim 16 above).

As to claims 21 and 29, while Matthews discloses storing said electronic publication, he fails to specifically disclose an external data connection for downloading said electronic publication to a personal digital assistant (PDA).

The examiner takes Official Notice that it was notoriously well known in the art to use at the time of invention by applicant to download an electronic publication, including a television program guide, to a mobile handheld device which provides a user with

more freedom in where they can view the information, such as a typical PDA, for the typical benefits of providing a user-friendly, mobile means with which to view information.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Levitan's system to include downloading said electronic publication to a personal digital assistant (PDA) for the typical benefits of providing more freedom to a user through a user-friendly, mobile means with which to view information.

8. Claims 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levitan as applied to claim 7 above, and further in view of Bretschneider et al. (Bretschneider) (6,128,629).

As to claim 9, while Levitan discloses providing an electronic publication, he fails to specifically disclose an interactive menu as part of said electronic publication for skipping to different parts of the publication.

In an analogous art, Bretschneider discloses a system for providing electronic publications (column 3, lines 36-46 and column 6, lines 26-28) which provides a visual area with selectable links to automatically retrieve and display a different part of the publication (column 5, line 66-column 6, line 6). This provides a user friendly means to quickly move to different sections of the publication (column 5, line 53-column 6, line 6).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Levitan's system to include an interactive menu as part of said electronic publication for skipping to different parts of the publication, as taught

Art Unit: 2617

by Bretschneider, for the typical benefit of providing a user friendly means to quickly move to different sections of the publication.

As to claim 11, while Levitan discloses providing an electronic publication, he fails to specifically disclose embedding a hyperlink referencing an Internet site in said electronic publication.

In an analogous art, Bretschneider discloses a system for providing electronic publications (column 3, lines 36-46 and column 6, lines 26-28) which provides a visual area with selectable links to automatically access and retrieve data from an Internet site (column 5, line 66-column 6, line 18) for the typical benefit providing a user friendly means to locate and retrieve related content from a remotely located site (column 5, line 66-column 6, line 18).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Levitan's system to include embedding a hyperlink referencing an Internet site in said electronic publication, as taught by Bretschneider, for the typical benefit providing a user friendly means to locate and retrieve related content from a remotely located site.

As to claim 12, Levitan and Bretscheider disclose accessing said referenced Internet site upon selection of said hyperlink (see Bretschneider at column 6, line 2-18).

### ***Response to Arguments***



9. Applicant's arguments filed 07/05/05 have been fully considered but they are not persuasive.

a. On page 10, applicant argues that Matthews does not teach or suggest a system for distributing an electronic magazine that is independent of the television programming also included in the signal.

In response, Matthews specifically teaches transmitting an EPG for all television programming to the user on a periodic basis (column 7, lines 31-41). This clearly reads on the broad claim limitation of "independent" as the EPG is transmitted regardless of any television programming on the channel at the time.

b. On page 11, applicant argues that Matthews fails to teach or suggest a personal video recorder that stores both selected television programming and an electronic publication.

In response, as indicated in the rejection above, Matthews specifically discloses wherein the EPG is stored at the user site (column 7, lines 31-41) and wherein the user can select and record television programming (column 12, lines 16-27).

c. As to applicant's arguments in regards to claim 23, see (a) and the rejection above.

### ***Conclusion***

Art Unit: 2617

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Trovato (6,701,526) disclosing transmitting EPG data from a television receiver to a PDA.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

Art Unit: 2617

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda  
Patent Examiner  
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JS



**VIVEK SRIVASTAVA**  
**PRIMARY EXAMINER**